Remarks/Arguments

Reconsideration of the present application, as amended, is respectfully requested.

There were 10 claims in this application, as filed, claims 1 – 10. Claims 7 and 8 have been cancelled. Claims 3 – 5 have been previously amended. Claims 3 – 5 and 9 – 10 have been withdrawn from consideration as pertaining to nonelected subject matter. By this Amendment, Applicants have amended claim 1 and added new claims 11 – 16. The above mentioned amendments add no new matter to this application. Support for the amendments to claim 1 and for new claims 11 – 16 can be found in the description of various embodiments of the invention on pages 1 and 2 of the specification and in the Example on page 4 of the specification.

Claims 1 – 2 and 6 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent 6,004,565 to Chiba *et al.* (hereinafter "Chiba"). For the reasons that follow, Applicants traverse this rejection and submit that claims 1 – 2 and 6, as amended, are nonobvious and patentable over Chiba, and they respectfully request that such rejection be withdrawn.

Chiba discloses compounds that are useful in inhibiting an immune response by an immunosuppression mechanism known as accelerated lymphocyte homing immunosuppression ("ALH-immunosuppression"). Chiba describes two genera of compounds, one acyclic and one monocyclic, that represent ALH-immunosuppressive compounds. The Examiner has taken the position that the compounds of claim 1 are embraced within the cyclic genus, the description of which begins in column 3 at line 46 of Chiba and ends in column 4 at line 41.

The definition of the substituent "W" in the cyclic genus of Chiba reads as follows: "*W is hydrogen; a straight or branched chain alkyl having 1 to 6 carbon atoms; a straight or branched chain alkenyl having 1 to 6 carbon atoms; a straight or branched chain alkynyl having 1 to 6 carbon atoms; a phenyl, which may be substituted by hydroxy; R4(CH$_2$)$_m$;* **or a straight or branched chain C_1 – C_6 alkyl substituted by 1 – 3 substituents selected from the group consisting of a halogen, a cycloalkyl and a phenyl, which may be substitued by hydroxy;**". Applicants submit that the compounds of claim 1 of the present invention do not fall within the scope of the cyclic genus of Chiba because the definition of W does not include hydroxymethyl or any hydroxyalkyl group. The substituent group "hydroxymethyl" does not fall within the italicized portion of the definition of W because it is not an unsubstitued alkyl group and, clearly, the italicized term "*which may be substituted by hydroxy*" refers only to the immediately preceding "phenyl", because each of the options for the different identities of W are separated by semicolons, such that the italicized language "*a phenyl, which may be substituted by hydroxy*" represents a separate and distinct option for the identity of *W*. Applicants further submit that "hydroxymethyl" is not embraced within the portion of the definition of W that begins with "or", which is bolded above, because hydroxymethyl is an alkyl group that is substituted with hydroxy, in contrast to an alkyl group substituted with a substituent that is substituted with

hydroxy. This is true regardless of whether one reads the phrase "**which may be substituted with hydroxy**", in the bolded portion of the definition of W above, to refer only to the immediately preceding "phenyl" or to any of the preceding "halogen", "cycloalkyl" and "phenyl". In the Office Action mailed to Applicants attorney on July 16, 2009, the Examiner indicated that the definition that Chiba likely intended and the one upon which her rejection was based is the one wherein "any of halogen, cycloalkyl and phenyl" may be substituted with hydroxy. Applicants submit that, as indicated above, even adopting the definiton used by the Examiner, the presently claimed compounds, as amended, to not fall within the genus of Chiba.

Applicants further submit that one of skill in the art of organic chemistry or pharmaceutical chemistry reading Chiba would not conceive of the presently claimed compounds with any expectation, let alone a reasonable expectation, that they would be active as ALH-immunosuppressive compounds. Not only are they outside both genera of compounds stated in Chiba to possess such activity, but they are substantially different structurally from the only individual ALH-immunosuppressive compound mentioned in Chiba, FTY720. All the presently claimed compounds differ from FTY720 at least by the presence of a second phenyl group. The compound, FTY720, is not only the only ALH-immunosuppressive compound mentioned in Chiba, but it is stated to be a preferred compound and is the subject of all nine examples in the specification of Chiba.

In view of the above arguments, Applicants submit that all pending claims, as amended, are nonobvious and patentable over Chiba, and they respectfully request that the above rejection under 35 U.S.C §103(a) be withdrawn.

Respectfully submitted,

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